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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
10/645,233	08/21/2003	Richard Anthony Riley		7159

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Richard A. Riley
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Bridgeport, OH 43912

EXAMINER

FISCHMANN, BRYAN R

ART UNIT PAPER NUMBER

3618

DATE MAILED: 09/22/2004

Please find below and/or attached an Office communication concerning this application or proceeding.

Office Action Summary

Application No.

10/645,233

Applicant(s)

RILEY ET AL.

Examiner

Bryan Fischmann

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-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 2 MONTH(S) FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If the period for reply specified above is less than thirty (30) days, a reply within the statutory minimum of thirty (30) days will be considered timely.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

- 1) ☒ Responsive to communication(s) filed on 22 August 2003.
- 2a) ☐ This action is **FINAL**. 2b) ☐ This action is non-final.
- 3) ☒ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims

- 4) ☒ Claim(s) 1-20 is/are pending in the application.
- 4a) Of the above claim(s) _____ is/are withdrawn from consideration.
- 5) ☐ Claim(s) _____ is/are allowed.
- 6) ☐ Claim(s) _____ is/are rejected.
- 7) ☒ Claim(s) 1-20 is/are objected to.
- 8) ☐ Claim(s) _____ are subject to restriction and/or election requirement.

Application Papers

- 9) ☒ The specification is objected to by the Examiner.
- 10) ☒ The drawing(s) filed on 22 August 2003 is/are: a) ☐ accepted or b) ☒ objected to by the Examiner.
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).
Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

Priority under 35 U.S.C. § 119

- 12) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☐ All b) ☐ Some * c) ☐ None of:
- ☐ Certified copies of the priority documents have been received.
 - ☐ Certified copies of the priority documents have been received in Application No. _____.
 - ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

* See the attached detailed Office action for a list of the certified copies not received.

Attachment(s)

- | | |
|--|---|
| 1) <input checked="" type="checkbox"/> Notice of References Cited (PTO-892) | 4) <input type="checkbox"/> Interview Summary (PTO-413) |
| 2) <input type="checkbox"/> Notice of Draftsperson's Patent Drawing Review (PTO-948) | Paper No(s)/Mail Date. _____ |
| 3) <input checked="" type="checkbox"/> Information Disclosure Statement(s) (PTO-1449 or PTO/SB/08) | 5) <input type="checkbox"/> Notice of Informal Patent Application (PTO-152) |
| Paper No(s)/Mail Date <u>11-24-2003</u> | 6) <input type="checkbox"/> Other: _____ |

Specification

1. The disclosure is objected to because of the following:

A) The following recited phrases are unclear, awkwardly worded, and/or grammatically incorrect:

1) Lines 109 and 110 recite "The blocking means extends upwardly from said channel at least 27.5 degree above the horizontal".

This recitation is objected to due to the following:

a) The term "blocking means" is best understood to correspond to reference numbers 51 and 52. The "channel" is best understood to correspond to reference number 40.

b) From examination of the drawing figures, reference number 40 appears to be a flat surface that would be horizontal with the front and rear shoe portions, reference numbers 11 and 12, placed on a ground surface. Reference numbers 51 and 52 curve upwardly from reference number 40, on each shoe portion, along an arc at the forward end of the forward shoe portion and the rear end of the rearward shoe portion.

c) From this, it is unclear how an "angle" may be measured between a flat surface, reference number 40 and an "arcuate surface", reference numbers 51 and 52.

See also similar recitations on pages 5, 6, 8 and 10 of the specification.

Note also that the term "degree" in the above recitation is grammatically incorrect.

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2) The use of the trademark "VELCRO" has been noted in this application on page 11. It should be capitalized wherever it appears and be accompanied by the generic terminology.

Although the use of trademarks is permissible in patent applications, the proprietary nature of the marks should be respected and every effort made to prevent their use in any manner which might adversely affect their validity as trademarks.

B) The specification is objected to as failing to provide proper antecedent basis for the claimed subject matter. See 37 CFR 1.75(d)(1) and MPEP § 608.01(o).

Correction of the following is required:

Claims 8 and 9 recites the term "overmolding". The Examiner cannot find support for this term in the disclosure.

See also a similar objection in claims 19 and 20.

Drawings

2. The drawings are objected to as reference number 51 on Figure 5 lacks a lead line.

Claim Objections

3. Claims 1-20 are objected to because of the following:

Note: The claims are considered to be replete with objectionable matter.

Therefore, a comprehensive listing of all objectionable matter cannot be guaranteed.

Applicant is advised to review all claims for objectionable matter.

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A) Claim 1 recites "said blocking means extends upwardly from said channel at least 27.5 degrees above the horizontal plane...".

See also similar recitations on pages 5, 6 and 10 of the specification.

This recitation is objected to due to the following:

1) The term "blocking means" is best understood to correspond to reference numbers 51 and 52. The "channel" is best understood to correspond to reference number 40.

2) From examination of the drawing figures, reference number 40 appears to be a flat surface that would be horizontal with the front and rear shoe portions, reference numbers 11 and 12, placed on a ground surface. Reference numbers 51 and 52 curve upwardly from reference number 40, on each shoe portion, along an arc at the forward end of the forward shoe portion and the rear end of the rearward shoe portion.

3) From this, it is unclear how an "angle" may be measured between a flat surface, reference number 40 and an "arcuate surface", reference numbers 51 and 52.

See also other similar recitations in claims 1, 2, 10 and 11.

B) The recitation of "the foremost wheels" of an inline skate in claim 1, line 348 is objected to, as the recitation "foremost wheels" implies that it has already been set forth that the in-line skate consists of enough wheels such that there are "foremost wheels" (plural).

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Note that some in-line skates have only two wheels, so it is not considered obvious that the in-line skate must contain "foremost wheels".

C) The recitation of "the front wheel" in claim 1, line 349 is objected to, as it has previously only been established that there are "foremost wheels", and not specifically a "front wheel".

See also claim 10 for a similar objection.

See also the recitation of "the rear wheel" in claims 1 and 10.

D) Claim 1 recites "said channel" on line 357.

Since Applicant has already previously recited in the claim both "a front wheel-receiving channel" and "a rear wheel-receiving channel" in claim 1, to be clear, Applicant should specify which "receiving channel" is being referred to in line 357.

As best understood, Applicant is intending to refer to the "rear wheel-receiving channel" on line 357.

See also a similar recitation in claim 10.

E) Line 359 of claim 1 recites "the axes of the skate wheels". It is requested Applicant clarify which "axes" are being referred to.

F) The meaning of the term "overmolding" recited in claims 8 and 9 is considered unclear.

See also a similar objection in claims 19 and 20.

Allowable Subject Matter

4. Claims 1 and 10 would be allowable if rewritten or amended to overcome the claim objection set forth in this Office action.

5. Claims 2-9 and 11-20 would be allowable if rewritten to overcome the claim objection set forth in this Office Action and to include all of the limitations of the base claim and any intervening claims.

Reasons for Allowance

6. The following is an Examiner's statement of reasons for allowance of independent claims 1 and 10:

Claim 1 recites the limitation of an expandable shoe capable of being secured to an in-line roller skate comprising; a front shoe portion, a rear shoe portion, said front and rear shoe portions having a gap therebetween and connected and maintained in substantially horizontal alignment by a flexible bridge consisting of extensible substantially parallel elongate connecting rail members extending longitudinally across said gap. This limitation, in combination with the other limitations of claim 1, were not found in the prior art.

Note that claim 10 contains a similar recitation.

Any comments considered necessary by applicant must be submitted no later than the payment of the issue fee and, to avoid processing delays, should preferably accompany the issue fee. Such submissions should be clearly labeled "Comments on Statement of Reasons for Allowance."

Conclusion

7. This application is in condition for allowance except for the following formal matters:

The specification, drawing and claim objections as set forth in this Office Action.

Prosecution on the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

A shortened statutory period for reply to this action is set to expire **TWO MONTHS** from the mailing date of this letter.

8. The prior art made of record and not relied upon is considered pertinent to applicant's disclosure.


Kesner (2 patents), Evon, Lored, DiMegilo, et al and EP 1112760 – teach guards/scabbards for skates.

9. Any inquiry concerning this communication or earlier communications from the Examiner should be directed to Bryan Fischmann whose telephone number is (703) 306-5955. The examiner can normally be reached on Monday through Friday from 8:30 to 5:00.

If attempts to reach the Examiner by telephone are unsuccessful, the examiner's supervisor, Chris Ellis, can be reached on (703) 308-2560. The fax phone number for the organization where this application or proceeding is assigned is (703) 872-9306.

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Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free).

 9-17-4
BRYAN FISCHMANN
PRIMARY EXAMINER